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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,766	01/19/2000	Veronique Mahe	ROC-17	8806

7590 04/06/2004  
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EXAMINER

FUBARA, BLESSING M

ART UNIT PAPER NUMBER

1615

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/483,766

Applicant(s)

MAHE ET AL.

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Examiner acknowledges receipt of request for extension of time, declaration and petition, all filed 11/14/03. Petition was granted.

#### ***Allowable Subject Matter***

1. The indicated allowability of the pending claims is withdrawn in view of rejection below.

#### ***Claim Rejections - 35 USC § 112***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 4, 11 and 24-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 continues to recite the trademark/trade name "SG 809A." However, because dependent claim 18 recites "said fragrance," examiner takes the position that claim 4 intended to recite fragrance. Therefore, claim 4 is examined as comprising fragrance. Correction is respectfully requested.

Claim 11 recites "in particular" in line 2. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced

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by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 11 recites the broad recitation of at least one hydrating agent, and the claim also recites "in particular glycerol," which is the narrower statement of the limitation.

Claim 21 is a composition that is consisting essentially of ...; claim 24-37 that depend directly or indirectly from claim 1 now comprises ...; these claims cannot further contain ingredients that would affect the novel characteristic of claim 21. Correction is requested.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-13, 15-17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Fowler et al. (5,534,265).

Fowler discloses a cleansing composition comprising menthol, menthyl lactate, sodium lauryl sulfate, sodium laureth sulfate, cetyl dimethyl betaine, sodium cocoyl isethionate, glycerin, polyethylene glycols, fragrance, anti-oxidants, preservatives, polyquaternium-10, glycerol, propoxylated glycerol, carboxymethyl cellulose and hydroxypropylcellulose; Fowler teaches a

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cleansing composition comprising 0.1% to 10% menthol and menthyl lactate (claims 1 and 2, column 2, lines 26-44; column 4, line 18 to column 5, line 32, column 6, line 62-46; column 9, lines 13-32; column 10, line 7 to column 12 line 26, column 19, lines 25-63). The comprising language of the instant claims permits the presence of other ingredients in the composition. In the instant claims the ratio of menthol to menthyl lactate is in the range of from about 1/3 to about 1/10 and the amounts of menthol at from about 0.01% to about 2% by weight and menthyl lactate from about 0.1% to about 10% in the composition would satisfy the ratio. In the prior art, because amounts of menthol and menthyl lactate lie within and overlap the recited range, a certain composition of the prior art would have the recited ratio of menthol to menthyl lactate. In the claims, "not being irritating to sensitive parts of the human body" carries no patentable weight and a prior art composition that meets the limitation of the instant composition would inherently not irritate sensitive parts of the human body. Fowler meets the limitation of the claims.

6. Claims 1-3, 15-17 and 21-23 are rejected under 35 U.S.C. 102(a) as being anticipated by Koga (JP 10,231,238).

Koga in JP 10,231,238 teaches a cosmetic composition that is prepared by adding 0.001-10.0 weight percent of menthol and at least one of menthyl lactate, menthyl glycoside menthyl hydroxybutyrate, menthoxypropanediol and menthoxyfurane (abstract). In the instant claims the ratio of menthol to menthyl lactate is in the range of from about 1/3 to about 1/10 and the amounts of menthol at from about 0.01% to about 2% by weight and menthyl lactate from about 0.1% to about 10% in the composition would satisfy the ratio. In the prior art, because amounts of menthol and menthyl lactate lie within and overlap the recited range, a certain composition of

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the prior art would have the recited ratio of menthol to menthyl lactate. In the claims, “not being irritating to sensitive parts of the human body” carries no patentable weight and a prior art’s composition that meets the limitation of the instant composition would inherently not irritate sensitive parts of the human body. Thus, Koga meets the limitations of the claims.

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 14, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler et al. (US 5,534,265).


Fowler discloses the instant composition but does not teach the amounts recited in claims 14, 18 and 20. It is within the purview of the person of ordinary skill in the art to formulate a composition that have specific amounts of the various components that would provide a composition for cleansing the skin and hair. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made formulate a composition that comprises menthol and menthyl lactate according to the teaching of Fowler. One having ordinary skill in the art would have been motivated to formulate the skin or hair cleansing composition of Fowler using amounts that are expected to provide a composition that would yield non-abrasive personal cleansing composition.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 242-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Blessing Fubara  
Patent Examiner  
Tech. Center 1600